

REMARKS

Reexamination and reconsideration of claims 29 and 31-36 are respectfully requested. Applicants acknowledge and appreciate the allowance of claims 1-14 and 38-45. Additionally, claims 15-28, 30, and 37 have been previously cancelled previously without prejudice.

Claims 29 and 31-36 were rejected under 35 U.S.C. sec. 103(a) applying U.S. Pat. Pub. No. 2005/0074293 (the '293 publication) in view of U.S. Pat. No. 4,812,078 (the '078 patent). For patents and/or publications to be applicable under sec. 103(a), the combination of teachings must, *inter alia*, expressly or inherently, teach, disclose, or otherwise suggest each and every feature of the claimed invention. Additionally, motivation and suggestion to combine the patents must be present.

It is respectfully submitted that the Office Action misinterpreted the references since the purported modification does not teach, disclose, or otherwise suggest each and every feature of independent claim 29. Specifically, the Office Action states the following, in part, on pp.2-3 regarding the '293 publication:

Searby '293 disclose a method for placing a duct in a surface comprising the steps of: with regard to claim 29, forming a channel of predetermined width in the surface; and placing the duct into the channel, thereby forming a friction fit between the duct and the channel over a portion of the length of the cut, wherein the duct has a diameter greater than the predetermined width of the channel (paragraph 0033); and with regard to claim 32, further comprising the step of placing a filling material into the channel that overlies the duct, thereby at least partially filling the channel and covering the duct (paragraph 0029).

It is respectfully submitted that there is no objective evidence whatsoever that the '293 publication teaches,

10/724,445
C0034
Page 8

discloses, or otherwise suggests the "...duct has a diameter greater than the predetermined width of the channel (paragraph 0033)." Instead, paragraph [0033] of the '293 publication states the following:

[0033] In the second instance, unlike blade type systems that gouge a slit into the turf, and trencher systems that completely remove the soil to form a trench, the underground cable laying apparatus of the present invention merely opens a slit in the turf, which is quickly reclosed once the cable has been placed therein. The angular placement of the turf slicing wheels ensures a narrow slit is initiated in the turf, is slightly widened to allow placement of the cable therein, and then is immediately reclosed by providing angular downward and inward force of the sides of the slit opened by the turf slicing wheels. As a result, it is nearly impossible to observe where the slit was opened in the turf once the cable has been laid therein. This is especially true when the turf is moist, or has been recently watered.

Paragraph [0033] does not teach, disclose, or otherwise suggest that the "...duct has a diameter greater than the predetermined width of the channel..." as suggested by the Office Action. Instead, paragraph [0033] explicitly states that slit is widened to allow placement of the cable therein as indicated in bold. As discussed in the specification and illustrated by the Figures, laying apparatus 10 makes a slit that is widened by the turf slicing wheels 14,16 since they are angled to widen the slit before placing cable 68 therein.

More specifically, the objective evidence of the '293 publication reveals that the turf slicing wheels 14,16 are arranged to make a slit into the turf that is pushed open wider than the cable 68 being laid (i.e., the turf slicing wheels are angled to be spaced wider at the rear, thereby widening the slit in the turf before the cable is placed). Specifically, Fig. 5 of the '293 publication depicts a

10/724,445
C0034
Page 9

cross-sectional view of laying apparatus 10 in operation. As shown by Fig. 5, cable 68 is routed through cable feed tube 36 into the groove 48 of cable feed guide wheel 68. See paragraph [0025] of the '293 patent. As shown by Fig. 5 and Fig. 6, cable 68 fits entirely into groove 48 of cable feed guide wheel, thus groove 48 is slightly wider than cable 68.

Moreover, the '293 publication states that "[t]he cable feed tube 36 leads down ~~between~~ the turf slicing wheels 14 to a position rearward of the leading edges thereof. At this position the cable feed tube outlet 42 dispenses the cable to be laid in the slice in the turf which has been created by the turf slicing wheels 14,16." See paragraph [0025] of the '293 publication (emphasis added). Thus, the turf slicing wheels 14,16 are positioned wider (at the rearward position) than the cable feed tube 36 and thus they create a slit in the turf that is forced open wider than cable 68 being installed therein. Simply stated, the cable 68 passes through the cable feed tube 36 which is between the turf slicing wheels 14,16. Further, Figs. 1 and 2 depict that the cable feed tube outlet 42 extends between turf slicing wheels 14,16 thus they are positioned wider than the cable being laid. See Figs. 1 and 2 of the '293 publication.

Additionally, Fig. 4 reveals further evidence that the slit in the turf is opened wider than the cable being laid. Specifically, as shown in Fig. 4 the rear edges of turf slicing wheels 14,16 are wider than the groove 48 of the cable feed guide wheel 46. Thus, the skilled artisan can see that the cable passes into a slit in the turf that is wider than the cable being laid during the cable laying operation.

Consequently, the objective evidence of the '293 patent reveals that Office Action misinterpreted the same. For at

10/724,445
C0034
Page 10

least this reason a *prima facie* case of obviousness is lacking because the purported modification does not teach, disclose, or otherwise suggest each and every feature of independent claim 29.

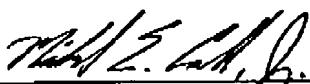
As an independent basis, there is no objective evidence of record indicating that the purported modification teaches, discloses, or otherwise suggests that the jacket of duct is compressed when placed within the channel. Thus, a *prima facie* case of obviousness is lacking for at least this reason. For at least these reasons, the withdrawal of the section 103(a) rejection of claims 29 and 31-36 is warranted and respectfully requested.

If any fees not previously authorized are due in connection with this Reply, please charge the fees, or credit any overpayment, to Deposit Account Number 03-3325.

Allowance of all pending claims is believed to be warranted and is respectfully requested.

The Examiner is welcomed to telephone the undersigned to discuss the merits of this patent application.

Respectfully submitted,



Michael E. Carroll, Jr.
Attorney
Reg. No. 46,602
P.O. Box 489
Hickory, N. C. 28603
Telephone: 828/901-6725

Date: 5/17/07